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REMARKS

Appellant hereby provides the Examiner additional notice of the fact that the present application was previously granted special status. An application for patent that once has been made special and advanced out of turn by the Office for examination will continue to be special throughout its entire course of prosecution in the Patent and Trademark Office, including appeal, if any, to the Board. (See MPEP 1204 & 708.02).

Further, the Examiner will, within 1 month from the date of receipt of applicant's formal reply, take up the application for final disposition. This disposition will constitute either a final action which terminates with the setting of a 3-month period for reply, or a notice of allowance. (See MPEP 708.02)

As stated in MPEP 708.02, during the 3-month period for reply, applicant is encouraged to arrange for an interview with the examiner in order to resolve, with finality, as many issues as possible. To this end, applicant hereby requests an interview with the Examiner, if a notice of allowance is not issued in response to the present amendment.

The Examiner has rejected Claims 1-25 under 35 U.S.C 103(a) as being unpatentable over MS Internet Explorer (IE) in view of Scullard et al. (US20020184095). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of

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success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

With respect to the first element of the *prima facie* case of obviousness, the Examiner states that "it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Scullard in the invention of IE in order to provide the users with the flexibility in organizing the sites visited." Applicant respectfully disagrees with this proposition, especially in view of the vast evidence to the contrary.

No Motivation Cited in References

For example, the Examiner fails to cite specific motivation in the above references to support the case for combining the same. The Examiner is reminded that the Federal Circuit requires that there must be some logical reason apparent from the evidence of record that would justify the combination or modification of references. *In re Regel,* 188 USPQ 132 (CCPA 1975).

References are Non-Analogous

Further, it is noted that IE relates to a web browser history function, while Scullard relates to a web browser favorites function. To simply glean features from a web browser history function, such as that of IE, and combine the same with the *non-analogous art* of web browser favorites functions, such as that of Scullard, would simply be improper.

Specifically, web browser history functions *unconditionally* and *automatically* store *all* previously visited web sites, for the particular purpose of allowing a user to back track to *any* previously visited site. In sharp contrast, web browser favorites functions allow a user to *selectively* and *manually* store visited web sites, for the particular purpose of allowing a user to quickly access *only favorite* sites.

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"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) In view of the vastly different types of problems web browser history functions address as opposed to web browser favorites functions, the Examiner's proposed combination is clearly inappropriate.

IE Reference Teaches Away

Further, by virtue of the sole focus of IE on a web browser history function, it is further argued that IE *teaches away* from the web browser favorites functions of Scullard. IE further *teaches away* from applicant's claimed invention, as noted below. *In re Hedges, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986).*

Note, for example, the description of the "history" feature below that was provided by the Examiner.

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Using History

You can revisit sites by using History. IE5 keeps a record of the sites you have visited for
up to three weeks. To backtrack to earlier sessions select View from the menubar, then
Explorer Bar and then History. Or just click on the History button in the toolbar.

The History Folder will appear down the left side of the screen and the page you were viewing will be
shifted to the right. A list of the sites that you have visited are displayed in this frame. Most sites will
have a yellow folder preceding the URL. Click on the yellow folder to see a list of the pages you have
visited at that site.
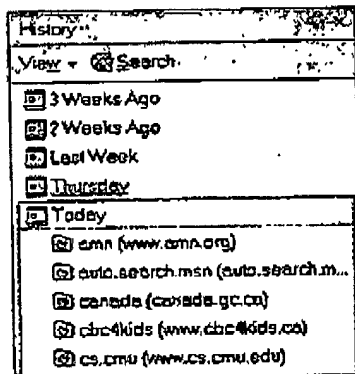
The record keeping of visited sites carried out by the "history" feature
requires that identifiers simply be <u>automatically</u> <u>post</u>-selected <u>after</u> a page is
browsed in a manner that is transparent to the user (e.g. by simply post-selecting the
identifier <u>to match the title and/or URL of the web page</u>, etc.). To allow a user to
manually pre-select identifiers (in the context claimed) during such tracking would
defeat the purpose of the "history" feature, as it would entail too much user
intervention in order to provide the convenient "backtracking" mentioned above. To
this end, the "history" feature of IE *teaches away* from applicant's claimed
invention.

Scullard Reference Teaches Away

It is further noted that Scullard *teaches away* from applicant's claimed
invention. Specifically, it is noted that Scullard teaches the same <u>post-selection</u> of
the identifier as that disclosed in the prior art addressed in applicant's Petition to
Make Special. Note similarity of Figure 2 of the Petition to Make Special of May
24, 2004 and Figures 6-7 of Scullard.

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In order to store content that is currently displayed, Scullard must select an "add to favorites" selection. In response to such selection, a plurality of available identifiers is displayed for allowing a user to select one of the identifiers, in association with which the content may be organized. See Figure 7 from Scullard below.
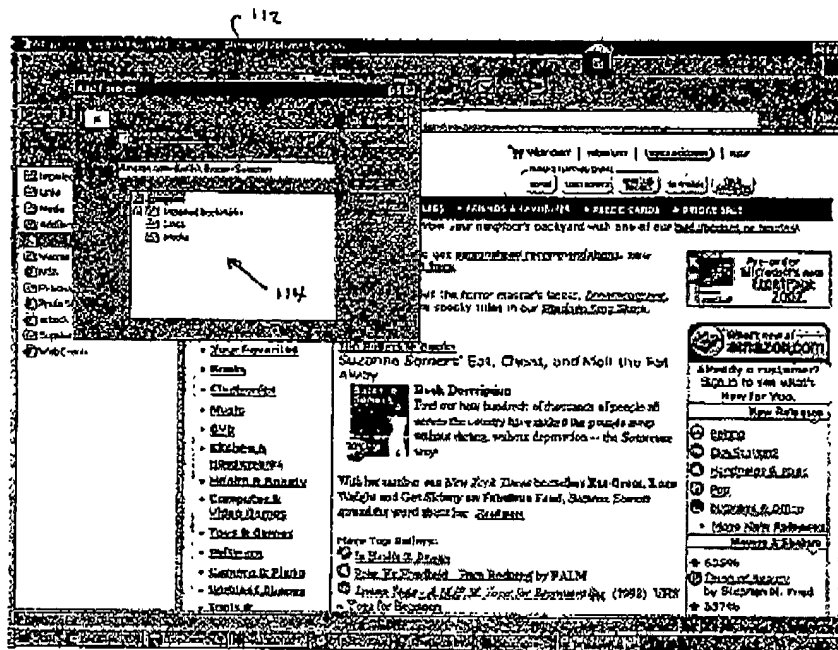

FIG 7

Thus, when a user wants to browse a network and store network content in association with one particular identifier, the user <u>must</u> "<u>post-select</u>" (i.e. select afterwards) the desired identifier using a menu (again, see Figure 7), for content to be stored in association with one particular identifier.

Such Scullard excerpt thus discloses a diametrically-opposed feature, namely <u>post-selection</u>, with respect to applicant's claimed <u>pre-selection</u>, as claimed. Therefore, Scullard clearly *teaches away* from applicant's claimed invention.

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Claim Language is Still Not Met

Sub-Argument #1

More importantly, with respect to the third element of the *prima facie* case of obviousness regarding Claim 1, for example, the Examiner relies on [0008], [0009], [0014], and [0018] from Scullard to meet applicant's claimed technique "wherein the user is allowed to manually enter the pre-selected identifier which is non-inclusive of any portion of the URLs."

In order to store content that is currently displayed in Scullard, one must select an "add to favorites" selection. In response to such selection, a plurality of available identifiers is displayed for allowing a user to select one of the identifiers, in association with which the content may be organized. See Figure 7 from Scullard below.
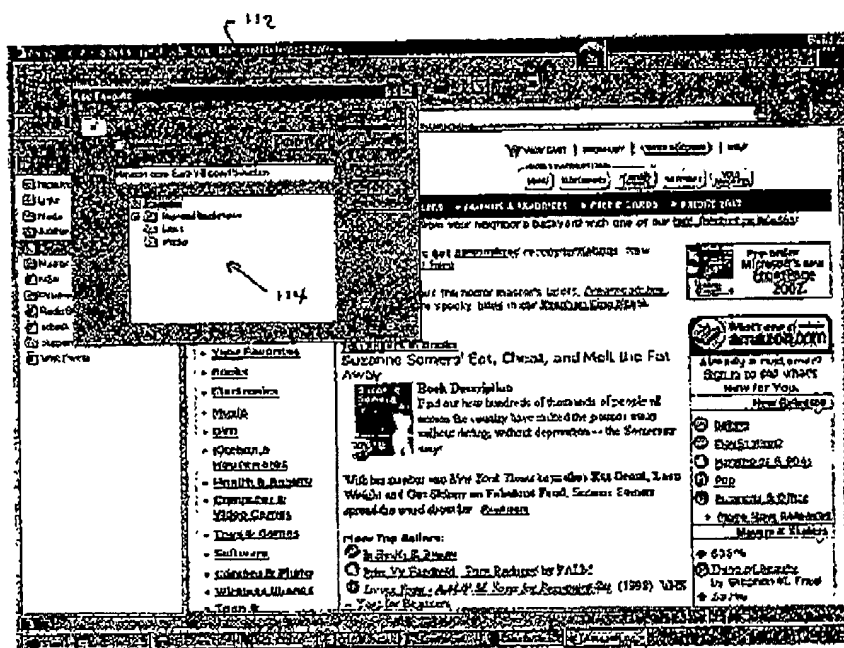

FIG 7

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Thus, when a user wants to browse a network and store network content in association with one particular identifier, the user <u>must</u> "<u>post-select</u>" (i.e. select afterwards) the desired identifier using a menu (again, see Figure 7), for content to be stored in association with one particular identifier.

In sharp contrast, applicant teaches and claims a technique "wherein the user is allowed to manually enter the <u>pre-selected</u> identifier which is non-inclusive of any portion of the URLs" (emphasis added), as claimed. By this claimed feature, the cumbersome nature of the above prior art is avoided, since a user does not have to post-select an identifier when attempting to store content for offline use, in the manner described above.

Applicant respectfully asserts that the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest <u>all</u> of the claim limitations, as noted above. Nevertheless, despite such paramount deficiencies and in the spirit of expediting the prosecution of the present application, applicant has amended various independent claims to further distinguish applicant's claim language from the above reference, as follows:

"wherein, after the pre-selection, selected content associated with at least one of the URLs displayed during use of the network browser is correlated with the pre-selected identifier <u>in a manner that is dependent on a selection of the pre-selected identifier which is non-inclusive of any portion of the URLs,</u> and stored" (see Claim 1 – emphasis added);

"wherein, after the pre-selection, selected content associated with at least one of the URLs displayed during use of the network browser is correlated with the pre-selected identifier <u>which is separate from the URLs</u>" (see Claim 20 – emphasis added);

"wherein, after the pre-selection, selected content associated with at least one of the URLs displayed during use of the network browser is correlated with the pre-selected identifier <u>in a manner that is based on the</u>

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pre-selected identifier which is distinct with respect to the URLs" (see Claim 21 – emphasis added);

"wherein, after the pre-selection, selected content associated with at least one of the URLs displayed during use of the network browser is correlated with the pre-selected identifier in a manner that is a function of the pre-selected identifier which is different from the URLs, and stored" (see Claim 22 – emphasis added);

"wherein, after the pre-selection, selected content associated with at least one of the URLs displayed during use of the network browser is correlated with the pre-selected identifier as function of the selection of the pre-selected identifier which is non-inclusive of any portion of the URLs, and stored" (see Claim 23 – emphasis added); and

"wherein, after the pre-selection and upon selection, selected content associated with multiple URL's displayed during use of the network browser is correlated with the pre-selected identifier in a manner that is based on a selection of the pre-selected identifier which is different from the URLs and is capable of being manually added by the user, for being stored in user computer memory" (see Claim 24 – emphasis added).

Sub-Argument #2

With respect to Claim 1, for example, it is noted that the Examiner relies on "(Figs 2-5; selection of element 20 and 22 of fig. 2, and selection of element of 40 and 41 of Fig. 4 are stored in the folder 51 of fig. 5)" from IE to make a prior art showing of applicant's claimed technique "wherein, after the pre-selection and upon selection, selected content associated with multiple URL's displayed during use of the network browser is correlated with the pre-selected identifier." Further, the Examiner argues that "the user can pre-select one of the identifiers by clicking on one of the folders or making expand selection of fig. 6."

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It should noted, however, that the selection of the folders and, thereafter, the selection of element 20 and 22 of fig. 2 and element of 40 and 41 of Fig. 4, as suggested by the Examiner, will <u>unconditionally correlate the related content to a folder with an identifier that is specifically inclusive of the corresponding URL, at least in part</u>.

In sharp contrast, applicant claims, in Claim 1, a technique "wherein, after the pre-selection, selected content associated with at least one of the URLs displayed during use of the network browser is correlated with the pre-selected identifier <u>in a manner that is dependent on a selection of the pre-selected identifier which is non-inclusive of any portion of the URLs,</u> and stored" (emphasis added).

With continuing reference to Claim 1, it is again noted that the aforementioned distinctions (in the context claimed) offer numerous advantages (which further render such features *unobvious*). The tremendous benefit of such clear distinction may be illustrated with an <u>optional, non-limiting</u> example of use, set forth below.

In the present example, imagine a user performing Internet research relating to two separate fruits, namely apples and oranges. In such case, the user may be allowed to manually enter an apple identifier and an orange identifier, <u>which is non-inclusive of any portion of any URLs</u>, etc. The user may wish to first research apples. In the context of the claimed invention, the <u>user</u> would first "pre-select" the identifier reflecting "apples." "[T]hereafter" or "after the pre-selection," while browsing, the user may simply select content relating to "apples" for storage and correlation in association with the "pre-selected identifier," <u>which is non-inclusive of any portion of the URLs</u>, etc.

Similarly, after researching apples, the user may wish to then research oranges. In such case, the <u>user</u> may "pre-select" the identifier reflecting "oranges" and continue as set forth above, *without* having to "post-select" (i.e. select afterwards) the orange identifier for <u>each</u> orange-related content found during research.

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It is noted that IE and Scullard are simply incapable of such <u>optional, non-limiting</u> example of use, and associated advantages. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

While the foregoing arguments are set forth in the context of Claim 1, it is believed that the remaining independent claims are allowable, at least in part, for similar, but not identical reasons. Note, for example, the specific claim language of each of the independent claims.

It is further noted that the Examiner has <u>not</u> considered the full weight of all of applicant's claim language. Specifically, the Examiner has merely rejected Claims 20-24 "under the same rationale as claim 1." However, indicated below is exemplary language (in a form that preceded the above amendment) that was <u>not</u> fully considered in making such rejection.

> "wherein the pre-selected identifier is capable of being manually <u>modified by the user utilizing a user-selectable object adapted for modifying</u>" (emphasis added - see Claim 21)

> "wherein the pre-selected identifier is capable of being manually entered <u>by the user manually adding to the plurality of identifiers utilizing an icon adapted for adding to the plurality of identifiers</u>" (see Claim 23)

Again, applicants respectfully assert that at least the first and third element of the *prima facie* case of obviousness has not been met, for the reasons set forth hereinabove. A notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Applicant further argues that the Examiner's rejection is still deficient with respect to many additional claims. Just by way of example, the Examiner has not

even considered applicant's argument regarding Claim 9. Specifically, the Examiner relies on item 10 from Figure 11 below to make a prior art showing of applicant's claimed "wherein the identifiers include intellectual property identifiers" (see dependent Claim 9).
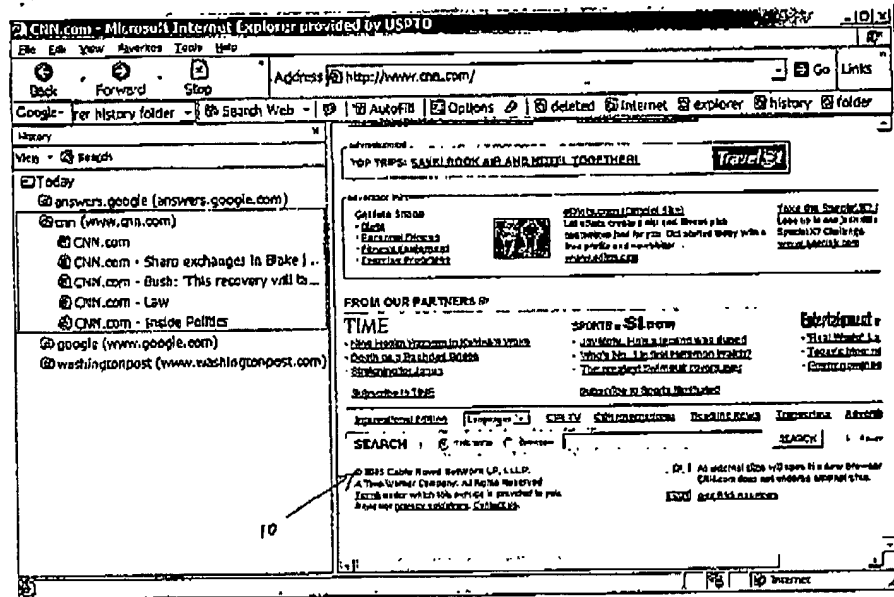
FIG. 11

After carefully reviewing such excerpt and the remaining IE reference, however, applicant respectfully disagrees with the Examiner's assertion. IE merely discloses an intellectual property identifier in association with the content browsed during use of the network browser, and not <u>identifiers</u> that include intellectual property identifiers, where the identifiers reside <u>adjacent to the window in which the content is displayed,</u> as claimed.

Again, applicants respectfully assert that at least the first and third element of the *prima facie* case of obviousness has not been met, for the reasons set forth hereinabove. A notice of allowance or specific prior art showing of each of the

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foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Applicant further argues that the Examiner's rejection is deficient with respect to the recently added claims. Just by way of example, the Examiner has rejected Claims 26-41 under 35 U.S.C. 103(a) as being unpatentable over IE in view of Rivette (USPN 2003/004307). In particular, the Examiner relies on Fig. 22-23B, [0395], [0369], and [0039] et al. from Rivette, in order to meet applicant's claimed "wherein a search is capable of being performed in association with at least one of a plurality of patents using at least one synonym, by:

identifying at least one claim associated with one of the patents,

extracting a plurality of terms from the claim,

identifying at least one synonym associated with at least one of the terms, and

conducting a search utilizing the terms and the at least one synonym" (see Claim 26).

First, it is noted that Fig. 22-23B are completely devoid of any sort of extraction of a plurality of terms from the claim. Further, [0395] makes no mention of the use of a thesaurus specifically with terms extracted from a claim. Finally, there is not even a suggestion of conducting a search based on the foregoing emphasized features.

It is also noted that the rejection of Claims 27-30 is deficient for similar reasons.

Again, applicants respectfully assert that at least the first and third element of the *prima facie* case of obviousness has not been met, for the reasons set forth hereinabove. A notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

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       In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. For payment of any fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. SVIPGP003B).

Respectfully submitted,

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